

## REMARKS

1. In response to the final Office Action mailed October 27, 2005, Applicants respectfully request reconsideration. Claims 1-32 were last presented for examination. In the outstanding Office Action, claims 1-32 were rejected. By the foregoing Amendment, claims 1, 22 and 24 have been amended. No claims have been added or canceled in this paper. Thus, upon entry of this paper, claims 1-32 will remain pending in this application. Of these thirty-two (32) claims, five (5) claims (claim 1, 22, 24, 31 and 32) are independent. Based on the above Amendments and following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

### *Art of Record*

2. Applicants acknowledge receipt of form PTO-892 identifying additional references made of record by the Examiner.
3. Applicants acknowledge receipt of the form PTO-1449 filed by Applicants on August 18, 2005, which has been initialed by the Examiner indicating consideration of the references cited therein.

### *Claim Rejections*

4. Independent claims 1, 22, 24, 31 and 32 and dependent claims 2-5, 6-8, 13, 16, 25-27 and 29-30 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2003/0101020 A1 to Matsushige (hereinafter, "Matsushige") in view of Japanese Patent No. 2000172536A to NEC CORP (hereinafter, "NEC"). Dependent claims 18-21 and 23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Matsushige in view of NEC as applied to claim 1 above, and further in view of U.S. Publication No. 2003/0101020 A1 to Hawkins, *et al.* (hereinafter, "Hawkins"). Based upon the above Amendments and following Remarks, Applicants respectfully request reconsideration and withdrawal of these rejections.

5. Independent claim 24, as amended, recites, in part:

intercepting one or more signals each indicative of one or more faults associated with one or more components of said electronic system during margin testing thereof; and generating at least one signal indicative of absence of said faults, thereby masking said intercepted signals.

6. In rejecting claim 24, the Examiner recognized that the primary reference, Matsushige, fails to teach intercepting and masking fault signals. Instead, the Examiner relied on NEC for allegedly disclosing “masking said intercepted at least one signal … by generating signals indicative of absence of said faults, thereby masking said intercepted signal.” (*See*, Office Action at pg. 9, stating “response signal (121) is not received”). Specifically, the Examiner relied on lines 4-6 of the Derwent Abstract of NEC, which recites “[w]hen the completion response signal is not received a diagnostic controller (4) releases the mask and outputs and interrupt signal.” (*See*, Office Action at pg. 11; although the Examiner cited lines 6-7, Applicants note that the Abstract of NEC only includes 6 lines).

7. Applicants respectfully submit that for at least the below discussed reasons, the Examiner’s reliance on the completion response signal (121) of NEC as allegedly disclosing “generating at least one signal indicative of absence of said faults, thereby masking said intercepted signals” is misplaced. As noted above, the completion response signal (121) of NEC is a signal that indicates that failure processing has completed. It does not, however, mask a signal indicative of one or more faults. Rather, NEC discloses the opposite. Particularly, when this completion response signal (121) is generated and received by the diagnostic controller of NEC, the diagnostic controller stops masking the interrupt signal. Thus, NEC’s disclosure of generating the completion response signal does not teach or suggest “generating at least one signal....thereby masking said intercepted signal,” as recited in claim 24.

8. Further, if the Examiner is relying on the disclosure of NEC of not generating the completion response signal 121 as allegedly disclosing “generating at least one signal,” Applicants disagree with the Examiner. Specifically, the failure to generate a signal cannot meet the claim limitation of “generating at least one signal.” Thus, it is impossible for the recitation in NEC of “response signal (121) is not received,” as stated by the Examiner, to meet the claim limitation of “generating at least one signal.”

9. As such, Applicants respectfully submit that claim 24 is allowable over the cited references for at least the reason that neither NEC nor Matsushige, whether taken alone or in combination, teach suggest “generating at least one signal indicative of absence of said faults, thereby masking said intercepted signal,” as recited by claim 24. Applicants, therefore respectfully request that the Examiner reconsider and withdraw the rejection to claim 24.

10. Applicants further respectfully submit that independent claims 1, 22, and 31, which include similar recitations to the above-discussed recitations of claim 24 are likewise allowable for at least the above-discussed reasons.

11. Independent claim 32 recites “a fault bypass module incorporated in said computer server...” In rejecting claim 32, the Examiner’s sole explanation regarding this rejection is “Examiner’s position is that Matsushige teaches a fault bypass module (port bypass circuit) incorporated in a computer server (e.g., Matsushige, [0066]).” (See, Office Action at pg. 11). Paragraph 0066 of Matsushige discusses Fig. 2, which is an enlarged view of a port bypass circuit and magnetic disk devices. This Figure illustrates that the port bypass circuit receives an input signal from a server (host device) via a fiber channel signal 11. (See, Matsushige at [0066], “The fiber channel (FC) signal 11, which is probed as an input via the host device 1, e.g., a host computer or a server, and the DKA 2, is sent to the ...of the port bypass circuit 5-1.”) Thus, contrary to the Examiner’s assertions, this relied on paragraph does not teach that the port bypass circuit is incorporated in a computer server. Rather, this paragraph teaches that the host (server) is external to the port bypass circuits.

12. As such, Applicants respectfully submit that claim 32 is allowable over the cited references for at least the reason that neither Matsushige nor NEC teach or suggest “a fault bypass module incorporated in said computer server.” Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 32.

***Failure to Comply with 27 C.F.R. §1.104(c)(2)***

13. Applicants further respectfully submit that the §103 rejections are improper because the Examiner has failed to comply with the requirements of 37 C.F.R. § 1.104(c)(2):

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

14. Contrary to the requirements of 37 C.F.R. § 1.104(c)(2), no attempt has been made in the Office Action to clearly explain the pertinence of the NEC reference for each rejected claim. Rather, the Examiner has merely provided one or two word phrases and a cite to a machine assisted translation of the NEC reference that is fraught with grammatical errors and terms that have no meaning in the English language. For example, in rejecting dependent claim 5 and 29, the Examiner provided no explanation whatsoever regarding the Examiner's basis for the rejection. Instead, the Examiner just cited to large swatches of the NEC reference with no attempt whatsoever to explain their pertinence. (*See*, Office Action at pg. 9). As such, Applicants respectfully submit that the Examiner's rejections of dependent claims 5 and 29 is improper for at least this additional reason.

15. Further, in rejecting claim 1, the Examiner's sole explanation for alleging that NEC teaches generating at least one signal indicative of absence of said at least one fault" is as follows: "response signal (121) is not received, Abstract, lines 4-5" and "failure process completion response signal (121) is not received, Abstract, lines 2-6." This mere recitation of "response signal (121) is not received" provides no explanation regarding its pertinence, and accordingly falls far short of the requirement under 37 C.F.R. §1.104(c)(2) that the Examiner must clearly explain the pertinence of the reference for each rejected claim.

***The Examiner has Failed to Provide Evidence of a Motivation to Combine***

16. The §103 rejections are *prima facie* improper because they provide no appropriate basis for combining Matsushige and NEC. As set forth in the Manual of Patent Examining Procedure (MPEP) at § 706.02(j), "To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, *either in the references themselves or in the knowledge generally available to one of ordinary skill in the art*, to modify the reference or to combine reference teachings (emphasis added) . . . The teaching or suggestion to make the claimed combination and the reasonable expectation of success ***must both be***

*found in the prior art and not based on applicant's disclosure* (emphasis added). *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

17. The Office Action attempts to justify combining Matsushige with NEC based on the following conclusory statement:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a mask controller (42) configured to intercept and mask signals as taught by NEC in a margin test method of Matsushige for the purpose of providing a mask controller (42) controls the masking of interrupt signal, based on failure generation indication output by a computer (NEC, Abstract). (*See*, Office Action at pg. 9).

18. The above quoted conclusory statement fails to properly identify any text in Matsushige, NEC or any other reference that would provide any motivation for combining Matsushige with NEC. Rather, the Examiner merely identifies particular elements disclosed in the Derwent Abstract of NEC, and then makes the conclusory statement that it would be obvious to use these elements (e.g., a mask controller) in the system of Matsushige. The Examiner, however, has identified nothing whatsoever that shows why someone would be motivated to combine these elements of NEC with Matsushige. Further, Applicants note that the NEC system is not directed to a margin testing system, but instead to a fault logging system. (*See*, NEC at Abstract).

19. As held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references. (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."); *Also see, In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.")).

20. As such, because the Examiner has failed to provide evidence of a motivation to combine NEC and Matsushige, Applicants respectfully request that the Examiner reconsider and withdraw the rejections under §103 for at least this additional reason.

***Translation Errors and §706.02***

21. Although the Examiner provided a translation of the NEC reference in response to Applicants MPEP §706.02 Request for a Translation, Applicants note that this translation still includes numerous translation errors making it impossible for Applicants to discern the precise facts the Examiner is relying on for rejections where the Examiner relied on portions of NEC other than the Abstract. For example, in rejecting claim 22, the Examiner relied on paragraphs 18-22 of NEC. The Examiner, however, failed to identify the components being relied on. Moreover, this large section of NEC is riddled with improper grammar and terms that have no meaning in the English language, e.g., “non mascuca bull interruption,” making this cited section nonsensical.

22. Additionally, it appears that the Examiner may be relying on information within the Examiner’s personal knowledge in rejecting the claims. For example, as discussed above, the Examiner has cited to sections of NEC that are not in the English language and the translation provided by the Examiner is grammatically incorrect. As such, if the Examiner is capable of reading the Japanese language, and is relying on his own translation of the NEC reference, Applicant hereby requests that the Examiner provide an affidavit pursuant 37 C.F.R. § 1.104(d)(2), that contains the facts supporting each of the Examiner’s assertions used as a basis for the rejections.

***Double Patenting Rejections***

23. The Examiner has rejected claims 1-32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 55-75 of U.S. Patent Publication No. 2004/0267482.

24. Applicants agree to file a terminal disclaimer disclaiming the terminal part of the statutory term of any patent granted on the captioned application, which would extend beyond the expiration date of the full statutory term of United States Patent Publication No. 2004/0267482 upon allowance of this application. Applicants respectfully assert that these rejections will be obviated by the filing of the terminal disclaimer.

25. Applicants have agreed to submit the terminal disclaimer solely to advance the prosecution of the application, without conceding that the double patenting rejection is properly based. In agreeing to file the terminal disclaimer, Applicants rely upon the rulings of the Federal Circuit that the filing of such a terminal disclaimer does not act as an

admission, acquiescence or estoppel on the merits of the obviousness issue. See, e.g., Quad Environmental Tech v. Union Sanitary Dist., 946 F.2d 870, 874-875 (Fed. Cir. 1991); Ortho Pharmaceutical Corp. v. Smith, 959 F.2d 936, 941-942 (Fed. Cir. 1992).

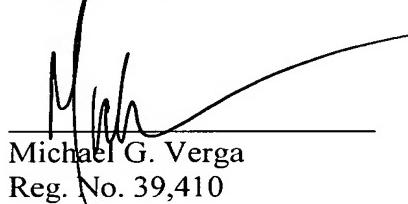
***Dependent Claims***

26. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them a fortiori and independently patentable over the art of record. Accordingly, Applicants respectfully request that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

***Conclusion***

27. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,



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